

REMARKS

Claims 12-41 are pending. Claims 42-49 are added. The basis for the new claims can be found, for example, at page 3, line 25 to page 4, line 6, page 5, lines 20-27, page 9, lines 23-24, and page 12, line 11 to page 14, line 19. Claims 31-41 are withdrawn.

Claims 12-30 stand rejected under 35 U.S.C. § 103 (a) as allegedly obvious over U.S. Patent No. 6,229,970 ("the Richards patent"). The Richards patent, however, does not describe any claimed invention in a way that would place it in the possession of those skilled in the art. *In re Arkley*, 172 U.S.P.Q. 524, 528 (CCPA 1972) ("The test which determines whether an invention has been anticipated by a reference is whether the description of the invention in the reference is sufficient to put the public in possession of the invention."). Nothing in the Richards patent teaches or suggests the use of gypsum of the particle size of the instant invention. Applicants note that, as taught at page 8, line 27 to page 9, line 3 of the instant application, WDP gypsum particles of differing dimensions are formed by different waste-gas desulfurization processes. Without more, the Richards patent does not present or suggest all elements of the instant claims and does render the instant claims obvious.

To further support the position that the instantly claimed invention is not obvious in view of the cited art, Applicants note that the instant compositions show an unexpected advantage of decreased shrinkage that is not taught or suggested by the art. See Example 2 on pages 15-16 of the instant application. No such guidance is found in the Richards patent.

Claims 12-30 stand rejected under 35 U.S.C. § 103 (a) as allegedly obvious over the Richards patent in view of U.S. Patent No. 5,169,617 ("the Clemmens patent"). To establish a proper *prima facie* rejection based on a combination of references, the following elements must be shown:

- (1) the references are available as prior art against the claimed invention;
- (2) the motivation (explicit or implicit) provided by the references that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do, not merely obvious to try; and

(5) the references teach the claimed invention as a whole.

Applicants submit that at least elements 2 and 4 have not been established. Hence, a *prima facie* obviousness rejection is improper. *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1983).

There is not sufficient motivation to combine the cited art. Even if the Clemmens patent shows that flu-gas desulfurization gypsum particles may be 200 microns or less, this, without more, does not provide motivation to combine. Nothing in the cited art suggests why one would pick the gypsum particles of the Clemmens patent over those of other flu-gas desulfurization processes, scrap gypsum or other sources of gypsum. In order to support such a combination, the Office must provide some evidence of why the references suggest such a combination. No evidence is presented. For at least this reason, Applicants request reconsideration and withdrawal of the rejection.

The office action appears to employ an improper "obvious to try" standard. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992). Without proper motivation to combine, Applicants' blue print is the only way to arrive at the claimed invention.

Applicants also disagree with the assertion that a burden has sifted to them to provide evidence that the flu-gas process of the cited art would not produce particles of the claimed size. Applicants respectfully note that the MPEP §2142 states:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.* ...The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must *expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

(emphasis added). As discussed above, the Office has not established a *prima facie* case of obviousness. Therefore, Applicants do not have the alleged burden.

DOCKET NO.: HENK-0016/ H-3497 PCT US
Application No.: 09/856,236
Office Action Dated: November 10, 2004

PATENT

In view of the foregoing arguments, it is respectfully submitted that a proper *prima facie* obviousness rejection has not been established. Applicants request reconsideration and withdrawal of the instant rejection.

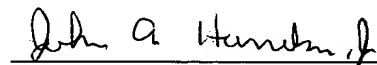
Applicants submit that new claims 42-49 are not anticipated by the aforementioned cited art for at least the reasons discussed above and because the new claims can not contain an appreciable amount of pulped paper (or cellulosic) fiber as required by the Richards patent (see, for example, the Abstract, and column 6, lines 13-15, and claim 1).

Additionally, Applicants submit that all claims are in condition for allowance and requests that the withdrawn claims be rejoined.

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

Date: January 31, 2005



John A. Harrelson, Jr., PhD
Registration No. 42,637

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439